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| 08/777,958 | 12/24/1996 | DONALD F. HAMILTON | 02103/211002 | 4029 |

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* DONALD F. HAMILTON and MICHAEL D. ROSEN

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Appeal 2010-000657
Application 08/777,958
Technology Center 2600

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Before MAHSHID D. SAADAT, JOHN A. JEFFERY,
and MARC S. HOFF, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304 or for filing a request for rehearing as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134 from the rejection of claims 1, 3-6, and 8-10. No other claims are pending (App Br. 1). We have jurisdiction under 35 U.S.C. § 6(b).[2]

We reverse.

## STATEMENT OF THE CASE

### *Introduction*

Appellants' invention relates to the placement of a low frequency audio speaker to affect improved frequency response in the interior of a vehicle with a trunk speaker that occupies negligible useful trunk volume (Spec. 1).

### *Exemplary Claim*

Independent Claim 1 is illustrative of the invention and reads as follows:

> 1. An audio speaker system for a vehicle having a passenger compartment, a spare tire compartment, a trunk having a trunk floor, a dividing portion and a rear deck, said dividing portion and said rear deck dividing the trunk and the passenger compartment, said audio speaker system comprising at least one low frequency speaker disposed within the trunk of the vehicle at the trunk rear in a location spaced from the passenger compartment by the portion of the trunk extending to the front of said vehicle such that said at least one speaker is clear of the rear deck above said trunk floor and outside said spare tire compartment,
>
> wherein said at least one speaker is disposed in a rearward section of the trunk occupying negligible useful trunk volume to cause a smaller decrease in calculated trunk volume than would occur with said at least one speaker mounted in said rear deck.

[2] An oral hearing for this application was held on January 12, 2011.

*Claim Rejections*

The Examiner relies on the following prior art in rejecting the claims:

| | | |
|---|---|---|
| Virva | US 4,164,988 | Aug. 21, 1979 |
| Hutchins | US 4,572,326 | Feb. 25, 1986 |
| Hathaway | US 5,394,478 | Feb. 28, 1995 |

Claims 1, 3-6, and 8-10 stand rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement.

Claims 1, 4-6, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hathaway.

Claims 1, 3-6, and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutchins and Virva.

## PRINCIPLES OF LAW

*Enablement*

To be enabling, the specification must teach those of ordinary skill in the art "how to make and how to use the invention as broadly as it is claimed." *In re Vaeck*, 947 F.2d 488, 496 (Fed. Cir. 1991). Furthermore, the specification, when filed, must enable one skilled in the particular art to use the invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); *see also Spectra–Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987).

*Written Description*

The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976);

*Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 265.

*Obviousness*

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *Kahn*, 441 F.3d at 988).

ANALYSIS

*1. 35 U.S.C. § 112, first paragraph, rejection*

The Examiner finds disclosure of how the calculated useful trunk volume based on the position of the speakers on the rear deck compared to the speaker in the rear of the trunk, on lines 16-17 of page 1 and lines 22-25 of page 2 of Appellants' Specification, is insufficient to disclose "how to compare the calculated useful trunk volume with one speaker (singular) being mounted in the rear deck" (Ans. 4). Appellants assert that our analysis of the Specification outlined in our decision on Appeal number 2007-003091

supports a finding that the written description requirement is satisfied (App. Br. 3-4).

We disagree with the Examiner's position and find that the cited portions of Appellants' Specification provide the necessary information to the skilled artisan for calculating the useful trunk volume without undue experimentation. In other words, the Examiner has failed to show that a person skilled in the art would not recognize in Appellants' disclosure a description of the invention defined by the claims. Therefore, because we find that Appellants' disclosure indicates that Appellants were in possession of the claimed subject matter at the time of filing of the application, the rejection of claims 1, 3-6, and 8-10 under the first paragraph of 35 U.S.C. § 112 cannot be sustained.

*2. 35 U.S.C. § 103(a) rejection over Hathaway*

Appellants assert that the speaker system depicted in Figure 5 of Hathaway does not show the electrodynamic driver 4 and the acoustic chamber 1 at the rear of the rearward section of the trunk (App. Br. 7). Further, Appellants argue that the speaker system of Hathaway cannot be considered to occupy negligible trunk space because they are more than half the height of the trunk (*id.*).

The Examiner relies on the statement "without significant reduction of storage space" in column 5, lines 12-13, of Hathaway and concludes that the disclosed speaker system meets the claimed requirement of "occupying negligible useful trunk volume" (Ans. 13-14). The Examiner further argues that placing the speaker in a rear part of the trunk would have been obvious since a limited number of locations, including the rearward section, in the

trunk would provide a suitable location "without significant reduction of storage space" (Ans. 14-15).

We agree with Appellants that the arrangement disclosed by Hathaway requires occupying a substantial volume in the trunk by placing the electrodynamic driver 4 and the acoustic chamber 1 anywhere in the trunk. Additionally, as contended by Appellants (Reply Br. 2-3), the Examiner's position does not provide how a large speaker system may be modified so that it would fit in a small enclosure in the rear corner of the vehicle trunk, occupying negligible useful trunk volume. In that regard, we agree with Appellants (App. Br. 7) that such modification was based on using the rejected claims as a template or blueprint, which results in impermissible use of hindsight. Accordingly, we do not sustain the 35 U.S.C. § 103(a) rejection of claims 1, 4-6, 9, and 10 over Hathaway.

*3. 35 U.S.C. § 103(a) rejection over Hutchins and Virva*

In rejecting claims 1, 3-6, and 8-10 over Hutchins and Virva, the Examiner relied on Virva for suggesting placement of a speaker in the trunk, not on the rear deck which was where Hutchins placed the speakers, without interfering with the storage handling capacity of the trunk (Ans. 9-10). The Examiner reasoned that because Virva implies placement of the speaker anywhere in the trunk, it would have been obvious to one of ordinary skill in the art to place the speaker in the rear corner of a rearward section of the trunk (Ans. 10).

As discussed above with respect to the rejection over Hathaway and as argued by Appellants (Oral Hearing; App. Br. 11-12), the Examiner has provided no convincing line of reasoning in support of modifying the speaker placement of Hutchins. As shown in Figures 2 and 3, Virva has an

adjustable air column tube speaker which occupies substantial trunk volume and cannot teach or suggest placement of the speakers of Hutchins in the rear corner of a rearward section of the trunk such that the speaker occupies negligible useful trunk volume, as required by the claims. *See KSR*, 550 U.S. at 418. Therefore, we do not sustain the 35 U.S.C. § 103(a) rejection of claims 1, 3-6, and 8-10 over Hutchins and Virva.

ORDER

Therefore, the Examiner's decision rejecting claims 1, 3-6, and 8-10 is reversed.

REVERSED

babc

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